

REMARKS

Claims 1-27 are pending in this application. All of the pending claims are rejected. None of the claims are currently amended. Reconsideration is requested.

Claims 1-5 are rejected under 35 U.S.C. 101 as not being one of four statutory categories. However, the question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to - process, machine, manufacture, or composition of matter, provided the subject matter falls into at least one category of statutory subject matter, but rather on the essential characteristics of the subject matter, in particular, its practical utility.”¹ Further, a method claim does not become non-statutory simply because it includes a computer program. As stated in MPEP 2106.01:

Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim. The same result occurs when a computer program is used in a computerized process where the computer executes the instructions set forth in the computer program. Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.

The Office will kindly note that what is recited in claims 1-5 is provisioning network services for a user application in an optical communication system, including “obtaining, from the optical network, the application-specific communication services for the user application.” The optical network is a physical apparatus including physical machines interconnected by a physical communication medium, and those physical machines are necessarily altered when service is obtained from them as recited in the claims, e.g., by physically repositioning mirrors in the case

¹ Interim Guidelines for Examination of Patent Applications
for Patent Subject Matter Eligibility

of a MEMs switch. The utility of the recited invention is to cause that alteration of the optical communication network in order to obtain application-specific services. Withdrawal of the rejection is therefore requested.

Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by US 7,197,546 ("Bagga"). It is well established that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The rejections are traversed for the reasons set forth below.

With regard to claims 1, 6 and 12, the Examiner asserts that ascertaining communication requirements and non-requirements of the user application, and determining a set of application-specific optical network communication services for the user application based at least in-part upon the ascertained communication requirements and non-requirements of the user application is shown in steps (600) and (602). However, there is no suggestion in Bagga of consideration of application-specific requirements or services. In step (600, figure 6) Bagga states "customer specifies the type of service." The associated text at column 7, lines 49-50 states "in step 600, the customer specifies the type of service that they would like to have." Step (602, figure 6) states "service request is captured in order manager and appropriate provisioning task model is initiated." The associated text at column 7, lines 50-51 states "in step 602, the service request is

captured in the Order Manager 280 and an appropriate provisioning task model is initiated.” As described in the Background of this application at page 2, line 32 through page 3, line 2:

Traditionally, such communication services have been very expensive, and need to be planned and scheduled well in advance. This is due in part because changes to the optical communication network, such as provisioning and switching optical communication paths, required substantial human intervention.

This is a problem because in addition to being slow and costly the procedure requires expert personnel and is prone to error and provisioning of unnecessary resources. The invention helps solve the problem by enabling applications to access network services having particular attributes.² More particularly, an OSA application component is tightly coupled to the user application to enable the user application to obtain network services³ without the human intervention described by Bagga. Applicant has emphasized the nature of the services as being application-specific and based on application requirements and non-requirements in previous responses. It would expedite prosecution of this application if those features were considered more specifically in any future Office Action.

With regard to claim 20 the Examiner asserts that the network user application including an optical service agent for obtaining application-specific optical communication services from the optical communication network via a user-to-network interface (UNI) sufficient to support operation of the network user application is described by Bagga at step (602, figure 6). As already stated above, Bagga fails to suggest anything application-specific about the requested services, but does suggest that the request is the typical manual request by customer personnel.

² Page 11, lines 12-14; page 12, lines 1-5.

³ Page 14, line 21 through page 15, line 2.

Claims 2-5, 7-11, 13-19, and 21-27 are dependent claims which further distinguish the invention, and which are allowable for the same reasons as their respective base claims.

Withdrawal of the rejections of claims 1-17 is therefore requested.

For the reasons stated above, this application is now considered to be in condition for allowance and such action is earnestly solicited. The Office is encouraged to contact Applicants' Attorney at 978-264-4001 or handerson@smmalaw.com to discuss any issues which might expedite allowance of this application.

Respectfully Submitted,

Date

/Holmes W. Anderson/
Holmes W. Anderson, Reg. No. 37,272
Attorney/Agent for Applicant(s)
Anderson Gorecki & Manaras LLP
33 Nagog Park
Acton, MA 01720
(978) 264-4001

Docket No. 120-177
Dd: 10/24/2007